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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,087	07/03/2003	Kazaya Katoh	24-007	5849
23400	7590	03/13/2008		
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			EXAMINER CHANG, VICTOR S	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 03/13/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/612,087	<b>Applicant(s)</b> KATOH ET AL.	
	<b>Examiner</b> Victor S. Chang	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2008 and 07 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4-7,9,15-20,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,4-7,9,15-20,22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Introduction***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submissions filed on 1/4/2008 and 12/7/2007 have been entered.
2. Claims 2, 4, 7, 15-17, 19, 20, 22 and 23 have been amended. Claims 1, 3, 8, 10-14 and 21 have been cancelled. Claims 2, 4-7, 9, 15-20, 22 and 23 are active.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

### ***Rejections Based on Prior Art***

5. Claims 2, 7, 9, 15, 19, 22 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Moreno [US 20040053044A1].

Moreno relates to a conformable thick edge adhesive tape. Fig. 3 illustrates that the adhesive tape is a laminate comprising a plurality of adhesive segments 20 (adhesive portions having a predetermined form), two adhesive sides 18, and a backing 12 [0020]. The adhesive sides (protective members) 18 are thicker than the adhesive segments 20. The adhesive

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segments 20 are provided longitudinally in a central portion of the release sheet, and the protective members 18 are provided longitudinally on the release sheet along the edges of the backing 12. The adhesive segments 20 and the thick sides 18 are spaced apart (they do not overlap) [0028]. A low adhesion backsize (LAB) can be used (backing 12 is a release sheet). Other layers can be added to the tape, such as primers to increase the adhesion of adhesive layer to backing layer. [0027].

For claims 2, 7, 9 and 19, since Moreno teaches a conformable adhesive tape, it is clearly a flexible material and windable into a roll, and a wound roll of Moreno's adhesive tape reads on the structural features of the limitation "the adhesive layer being disposed between the base material and the release sheet so that the release sheet is releasably adherent to the adhesive sheet portion". Regarding the newly added limitation "the base material and the adhesive layer are made of different materials", Moreno's primer layer reads on the base material, which is clearly a different material from the adhesive layer.

For claims 15, 22 and 23, Moreno shows in Fig. 1 that adhesive sheet portions have a size and planar form. Since the newly added limitation "adhesive sheet portions have a planar form that is disc shaped" merely amounts to rearrange that shape of a planar form, it is not given patentable weight, because it does not modify the operation of the article. See MPEP § 2144.04.VI.C.

6. Claims 4-6, 16-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreno [US 20040053044A1].

The teachings of Moreno are again relied upon as set forth above.

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For claim 4, Moreno lacks a teaching that the protective member is shaped to intrude between the adhesive sheet so as to partially overlap the adhesive sheet. However, since Moreno's Fig. 1 illustrate that the protective member 18 partially overlaps a side of the adhesive 20, it would been obvious to change the shape of the protective member to have a shape that would intrude between the adhesive portions to provide protection thereto at the intruding portion.

For claim 5, the edge member can be 2-20 mils [0018].

For claim 6, the surface of the overlapping part is not more than 50% of the surface area of the adhesive sheet (because the edge of the adhesive sheet appears to be not more than 50% of the surface area of said sheet).

For claim 18, the tape is formed into a roll with an LAB layer on its rear surface providing the ability to unroll.

For claims 16, 17 and 20, since they are within the scope of rejected claims, they are also rejected for the same reasons as set forth above.

### ***Response to Arguments***

7. Applicants argue at Remarks page 10 that

“Moreno fails to teach or suggest, for example, “wherein said adhesive sheet comprises a base material and an adhesive layer, ... wherein the base material and the adhesive layer are made of different materials.” (See, e.g., claim 2.)”

However, since Moreno's primer layer reads on the base material, all the features in claim 2 are anticipated.

Applicants argue at page 11 that

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“changing a shape merely because shapes can be changed does not constitute a reason why the shape would have been changed, as required by the Supreme Court. The application discusses that the intrusions (sometimes referred to as "bolster portions 302A") ensure rigidity of the entire laminate sheet when it is wound into a roll, so that deformation of the roll can be suppressed.”

However, since Moreno's Fig. 1 illustrate that the protective member 18 partially overlaps a side of the adhesive 20, it would been obvious to change the shape of the protective member to have a shape that would intrude between the adhesive portions to provide protection thereto at the intruding portion.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1794